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| 10/534,454 | 12/13/2005 | Friedrich Kastner | 2005_0782A | 4789 |
| 513 7590 06/22/2010 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503 | | | | |
| EXAMINER KHATRI, PRASHANT J | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/534,454

Applicant(s)

KASTNER ET AL.

Examiner

PRASHANT J. KHATRI

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule (**WO 99/569964**) in view of Walter (**US 4146418**) and Reinhart (**EP0210620**), or alternatively, Walter in view of Kaule et al. and Reinhart. The PCT application was published November 11, 1999. Examiner would like to note that US Patent No. 6688221 is used as the translation as the specification for entry as a National Stage Application must be translated as filed into English. *See MPEP 1893.01(a)*.
4. Kaule discloses a method for producing security foils for various objects. Concerning claims 1-7 and 12, Kaule discloses producing a security foil by coating a carrier foil with a lacquer layer that is UV-curable, embossing the lacquer layer, wherein the embossed areas are filled in with ink or negatively-printed on, covered with a metal

layer and treated to provide an optical holographic metallized security feature (**FIG. 1; col. 6, lines 19+**). The material is cured prior to the filling of ink (**col. 6, lines 57+**). Kaule discloses the resultant laminate can be cut and the security element can be fastened to an object to be protected (**col. 8, lines 37+**). Given the above disclosure, Examiner takes the position that that the fastening means would include and encompass the presently claimed "further functional layers and/or adhesion layers" of claims 8 since a further fastening in the art is known to require an adhesive or other functional layer to provide adhesiveness and other functionalities.

While it is acknowledged that Kaule is silent to the UV-curable lacquer being "deep-drawable", it is noted that since Applicant broadly recites the limitation of a UV-curable lacquer, it is the Examiner's position that the UV-curable lacquer intrinsically would be "deep-drawable". Examiner also notes that the lacquer as presently claimed has the capability of being cured by ultraviolet radiation and further has the capability to be "deep-drawable". As such, given the above broad disclosure of a UV-curable lacquer in which the lacquer must only be capable of being "deep-drawable" that is presently claimed in conjunction with the disclosure of a UV-curable lacquer, it is the Examiner's position that given the broad disclosure, the material of Kaule would intrinsically meet the presently claimed limitation. Applicant is reminded that the recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears the responsibility for proving that the reference composition does not possess the

characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430.

Kaule discloses that security features are may be applied to any object (**col. 8, lines 37+**), but is silent to the security feature is 'for application onto a packaging film.' However, the limitation of 'for application onto a packaging film' is a statement of intended use, and must result in a structural difference between the prior art and the claimed intended use to be given patentable weight. See *MPEP 2111.02 II*. No structural difference can be discerned between the prior art and the present claims.

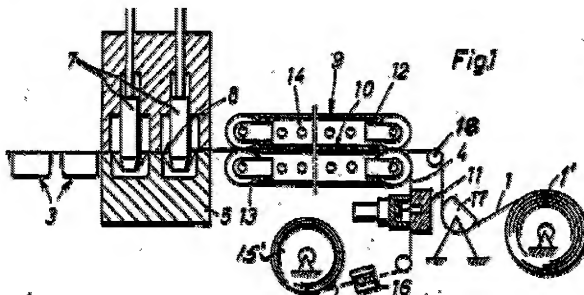
Therefore Kaule teaches a method for producing security features, that are capable of being applied to a packaging film, wherein the security label features comprise the layered structure as required by the instant claims including a carrier substrate, a UV-curable separation lacquer, considered to be capable of being deep-drawn, that is cured completely after being embossed by a mold, which is subsequently provided with additional functional layers including printed ink and adhesive layers, and wherein said features are cut to size to be transferred to an object. The security foils as shown by Kaule allow for continuous production process which is faster and more cost-effective than other processes (**col. 8, lines 13+**). However, Kaule is silent to a packaging film with such security labels regionally applied or a method of applying said features to a packing film and silent to pre-curing prior to embossing the lacquer and said lacquer having two or more different photoinitiators.

5. Walter teaches a deep-drawn packaging material and process for making said material, wherein a label and a planar packaging film material are simultaneously

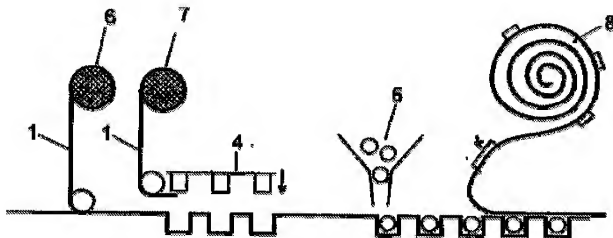
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laminated and deep-drawn to result in a three-dimensionally formed packaging material bearing a label that is fixedly secured on either one or two sides of the stamped cup-like shape formed as a result of the deep-drawing process (*Fig. 1, Fig. 3, elements 2 and 4 = label and label tape respectively and related text; Abstract; Cols 1-2, lines 54-68 and 1-28*):

Walter, Fig. 1:



Applicant's Invention, Fig. 2:



Walter teaches a method for applying labels to selected areas of a packaging material wherein the label tape is broken along pre-set breaking lines to form individual labels, which are passed through a preheating section of the forming apparatus to join the label and packaging film portion and is subsequently formed into a shape by deep-drawing and would meet the present limitations of claims (*Fig. 1 and related text; Cols 1-3, lines 60-68, 1-45, 1+*). Walter further discloses that such a process allows for combining a labeling method and deep-drawing formation of a labeled article that reduces the number of separate apparatus' needed punch and stack the labels onto an article which would meet the processing requirements of claims 16-19 (**col. 2, lines 29+**). Given the above disclosure of Kaule providing a label that has the capability of cut-to-size security features (i.e. endless form foil and disposing onto individual articles), Examiner takes the position that the substitution of the label of Walter with that of Kaule in combination with the process as shown by Walter, would meet the limitations of claims 16-19. As such, Walter further teaches a foil-containing label is attached to a deep-drawn article to form a packaged and labeled article. The process and apparatus

as shown by Walter allows for accurate positioning of the labels (*col. 1, lines 54+*).

However, Walter is silent to the labels having a security feature.

6. Reinhart disclose a method of making a film with a textured lacquer coating. The film is comprised of a support film and at least an embossed lacquer film wherein said lacquer film is partially cured prior to embossing and fully cured after embossing (***abstract***). The lacquer coating is comprised of a UV-curable material that contains two photoinitiators susceptible to two different wavelengths wherein one initiator initiates the partial curing and the other for complete curing (***abstract***). The two-part curing process allows for better adhesion to the support film due to the complete curing process and finer embossed features than the one step curing processes (***1st page, 3rd-6th paragraphs***). Examiner further notes that Reinhart discloses that the lacquer is comprised of acrylates, polyurethanes, and the like (***2nd page, 2nd full paragraph***). Given that the present invention appears to use the same materials, Examiner takes the position that the materials are capable of being "deep drawn". Thus, the combined disclosure of Kaule, Walter, and Reinhart would meet the presently claimed limitations of claim 13.

7. It would have therefore been obvious at the time the invention was made to one having ordinary skill in the art to modify the object to which the transfer foil security labels of Kaule are applied by substituting the general objects (documents of value, ID cards, passport, CDs) of Kaule with the packaging materials and process of in-mold labeling as taught by Walter because the labels of Kaule are capable of being applied to any variety of objects including packaging materials and because use of such security

features in the in-mold process disclosed by Walter would result in a packaging material with a label that is fixedly attached and integral with the packaging material that has an intrinsically improved anti-counterfeiting and authenticating feature. Further, as shown by Walter the apparatus and method shown combines a labeling method and deep-drawing formation of labeled articles that reduces the number of separate apparatus' needed to punch and stack the labels. As such, it would have been obvious to one of ordinary skill in the art, with the impetus to reduce production costs to use the system of Walter to produce an article containing the security features of Kaule to result in a deep-drawn package having the security features as disclosed above. Regarding the lacquer having two or more different photoinitiators, Reinhart disclose a method of making a film with a textured lacquer coating. prior to embossing and fully cured after embossing by means of two photoinitiators. The motivation to combine the above references is drawn to Reinhart which disclose the partial curing and fully curing allow for finer features to be formed and the resultant lacquer coating having better adhesion. As such, it would have been obvious to one of ordinary skill in the art to use two photoinitiators to allow for partial and full curing to take advantage of the better adhesion of the lacquer in Kaule and Walter and form finer structures.

8. Claims 9, 11, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule (**WO 99/569964**) in view of Walter (**US 4146418**) and Reinhart (**EP0210620**), or alternatively, Walter in view of Kaule et al. and Reinhart as applied to claim 1 above, and further in view of Zeiter et al. (**US 6494491**). The PCT application

was published November 11, 1999. Examiner would like to note that US Patent No. 6688221 is used as the translation as the specification for entry as a National Stage Application must be translated as filed into English. See *MPEP 1893.01(a)*.

9. Kaule, Walter, and Reinhart disclose the above; however, Kaule, Walter, and Reinhart are silent to the packaging film being a blister film or for strip packs.

10. Zeiter ('491) discloses a packaging material that has defined areas with one or more security features that are of holographic images or text ('491; Col. 2, lines 28-33). The security features taught by Zeiter may either be directly printed on or laminated onto the packaging film ('491; Col 3, lines 24-30). Zeiter teaches that the packaging forms may specifically be formed into packages such as push-through packs or blister packs, by stamping, sealing, deep drawing and/or stretch drawing ('491; Col 4, lines 14-24). Zeiter discloses that forgery-proof packaging or packaging material may serve as guarantee of origin, enabling the customer to recognize that the purchased item was actually manufactured and packaged by the desired manufacturer, as a guarantee that the item has not been tampered with and is not a fake (Col 1, lines 22-37), which is of great importance especially for the pharmaceutical, foodstuffs, cosmetics, software industries (Col 1, lines 11-21). The Examiner notes that blister packs taught by Zeiter may be in the form of a strip having multiple blisters, and therefore a strip pack, as is known in the pharmaceutical industry.

11. At the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the packaging film having at least one security feature as taught by Kaule in view of Walter and Reinhart or alternatively Walter in view of Kaule and

Reinhart to include blister films and strip packs as taught by Zeiter because the formation of in-mold security labels that are fixedly attached and integral with such blister films and strip pack materials will result in forgery-proof packaging or packaging that serve as a guarantee of origin, enabling the customer to recognize that the purchased item was actually manufactured and packaged by the desired manufacturer, as a guarantee that the item has not been tampered with and is authentic, which is of great importance especially for the pharmaceutical, foodstuffs, cosmetics, software industries.

Additionally, it would have been obvious to one having ordinary skill in the art to modify the type of packaging material taught by Kaule in view of Walter and Reinhart or alternatively Walter in view of Kaule and Reinhart to include blister and strip packs because such a modification to the form of the packaging material only requires a change in the shape and/or size of the material, where a change in size is generally recognized as being within the level of ordinary skill in the art, and the configuration is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration claimed was significant, see *MPEP 2144.04, IV*.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule (**WO 99/569964**) in view of Walter (**US 4146418**) and Reinhart (**EP0210620**), or alternatively, Walter in view of Kaule et al. and Reinhart with evidence provided by Bitner et al. (**US 5310060**). The PCT application was published November 11, 1999.

Examiner would like to note that US Patent No. 6688221 is used as the translation as the specification for entry as a National Stage Application must be translated as filed into English. *See MPEP 1893.01(a)*.

13. Kaule, Walter, and Reinhart disclose the above; however, Kaule, Walter, and Reinhart are silent to the packaging film being a blister film or for strip packs.

14. Regarding claim 10, Kaule in view of Walter and Reinhart or alternatively Walter in view of Kaule and Reinhart fails to specifically teach that the film is cold-formable. However, as evidenced by Bitner, cold-, thermo-, and pressure-forming are all equivalent conventional methods known in the art for forming blister and strip (blister sheet) packaging (*Col 13, lines 55-60*). The Examiner takes the position that the packaging material disclosed by Kaule in view of Walter and Reinhart or alternatively Walter in view of Kaule and Reinhart is capable of being cold-formed, and therefore meets the limitations of the instant claim.

Response to Arguments

15. Applicant's arguments, see p. 5, filed 6/14/2010, with respect to the 35 USC 112, 2nd paragraph rejection have been fully considered and are persuasive. The rejection of the above claim has been withdrawn.

16. Applicant's arguments, see p. 6, filed 6/14/2010, with respect to the 35 USC 102(b) rejection of claims 1-8 and 16-19 under Kaule have been fully considered and are persuasive. The rejection of the above claims has been withdrawn. It is noted that the present claims overcome the previous rejection.

17. Applicant's arguments, see p. 6-7, filed 6/14/2010, with respect to the 35 USC 103(a) rejection under Kaule in view of Walter or alternatively Walter in view of Kaule have been fully considered and are persuasive. The rejection under those references has been withdrawn. However, upon further reconsideration, Kaule and Walter are still applicable to the present claims. Applicant asserts that the combination of Kaule and Walter is silent to the presently claimed "cut-to-size" security feature and such a label is not introduced to a laminating gap of a laminating unit via guiding elements. Examiner respectfully disagrees and notes firstly that Kaule discloses an endless security foil wherein individual elements are disposed onto articles and as such teaches cut-to-size elements (**col. 8, lines 5+**). Walter teaches a labeling unit wherein the labeling tape is guided by into a heating and feeding unit (i.e. the laminating gap), further guided into a preset break cutting area, and then cut into the labels during the deep-drawing of the containers (**FIG. 1, cols. 2-3, lines 60+**). Given the above disclosure, it would have been obvious to one of ordinary skill in the art to substitute the security foil of Kaule and expect reasonable success with the process and apparatus of Walter to form a labeled container.

18. Applicant's arguments, see p. 7, filed 6/14/2010, with respect to the 35 USC 103(a) rejection of claim 10 under Kaule in view of Walter or alternatively Walter in view of Kaule with evidence provided by Bitner have been fully considered and are persuasive. The rejection of the above claim has been withdrawn. However, it is noted that in combination with Kaule, Walter, and Reinhart, the present claim has been met. Please see above for further details.

19. Applicant's arguments, see p. 8, filed 6/14/2010, with respect to the 35 USC 103(a) rejection of claims 9, 11, and 20 under Kaule in view of Walter or alternatively Walter in view of Kaule, further in view of Zeiter have been fully considered and are persuasive. The rejection of the above claims has been withdrawn. However, it is noted that Zeiter is still applicable to the present claims. Please see above for further details.

20. Applicant's arguments, see pp. 8-9, filed 6/14/2010, with respect to the 35 USC 103(a) rejection under Kaule in view of Reinhart have been fully considered and are persuasive. The rejection of the above claims has been withdrawn. However, upon further reconsideration Reinhart is still applicable to the present claims. Applicant asserts that the lacquer of Reinhart is not deep-drawable. Examiner respectfully disagrees and notes that Reinhart discloses that the lacquer is comprised of acrylates, polyurethanes, and the like (**2nd page, 2nd full paragraph**). Given that the present invention appears to use the same materials, Examiner takes the position that the materials are capable of being "deep drawn". Furthermore, it is noted that Applicant has only recited broad classes of lacquers and has provided no examples of specific materials. As such, given evidence to contrary, the Reinhart reference is still applicable to the present claims.

21. Applicant's arguments filed 6/14/2010 regarding the Kaule in view of Walter and Reinhart or alternatively Walter in view of Kaule and Reinhart have been fully considered but they are not persuasive. Applicant asserts that the lacquer of Reinhart is not deep-drawable. Examiner respectfully disagrees and notes that Reinhart discloses

that the lacquer is comprised of acrylates, polyurethanes, and the like and also has two or more photoinitiators (*2nd page, 2nd full paragraph*). Given that the present invention appears to use the same materials, Examiner takes the position that the materials are capable of being "deep drawn". Furthermore, it is noted that Applicant has only recited broad classes of lacquers and has provided no examples of specific materials. As such, given evidence to contrary, the Reinhart reference is still applicable to the present claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRASHANT J. KHATRI whose telephone number is (571)270-3470. The examiner can normally be reached on M-F 8:00 A.M.-5:00 P.M. (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1783

PRASHANT J KHATRI
Examiner
Art Unit 1783